THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JAMES A. FREGIEN and EARL J. SHANABROOK

_____

Appeal No. 97-1646
Application 08/080,890[1]

_____

ON BRIEF

_____

Before CALVERT, Administrative Patent Judge, McCANDLISH, Senior Administrative Patent Judge, and CRAWFORD, Administrative Patent Judge.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 6, 8 to 11 and 13, all the claims remaining in the application.

The claims involved are reproduced in the appendix to appellants' brief. Claims 8 and 10 are illustrative of the subject matter in issue:

[1] Application for patent filed June 22, 1993.

8. An apparatus for reducing the size of block propellant material comprising a means for remotely positioning a block of propellant between a cutting means and a means for remotely causing the cutting means to pass through the block of propellant thereby creating two or more smaller blocks of propellant.

10. A method of reducing block propellant comprising:

placing a propellant block between a cutting means and a retaining means, and

remotely causing the block propellant to contact the cutting means and forcing the cutting means to pass through said block propellant.

The references applied by the examiner in rejecting the claims are:

Lamb	3,217,768	Nov. 16, 1965
Costarelli	4,483,226	Nov. 20, 1984
Kühnert et al. (Kühnert)	5,386,318	Jan. 31, 1995 (filed May 12, 1993)

An additional reference, of record, applied in rejections herein pursuant to 37 CFR § 1.196(b), is:

Nix	4,020,723	May 3, 1977

The claims on appeal stand rejected as follows:

(1) Claims 1 to 6, 8 to 11 and 13, unpatentable for failing to comply with 35 U.S.C. § 112, second paragraph;

(2) Claims 1, 8 and 9, unpatentable over Costarelli in view of Lamb, under 35 U.S.C. § 103;

(3) Claims 5, 10, 11 and 13, unpatentable over Costarelli, under 35 U.S.C. § 103;

(4) Claims 2 to 4, unpatentable over Costarelli in view of Lamb and Kühnert, under 35 U.S.C. § 103;

(5) Claim 6, unpatentable over Costarelli in view of Kühnert, under 35 U.S.C. § 103.[2]

Rejection (1)

The examiner asserts that the claims on appeal do not comply with the second paragraph of § 112 in that they are indefinite on a number of different grounds.

(a) The examiner contends that various limitations in claims 1, 5, 8 and 11 are confusing and unclear because they imply that, contrary to appellants' disclosure, the cutting blades are not stationary.[3] For example, the examiner points to the expression "a remotely controlled means for causing said

[2] Rejections (4) and (5) are new grounds of rejection first raised in the examiner's answer. Appellants filed a reply brief in response.

[3] This ground of rejection would seem to be more aptly based on the first paragraph (lack of written description) of § 112.

cutting blades to pass through the block of energetic material" in claim 1, lines 8 and 9.

We do not regard this language as indefinite. A statement such as "causing the cutting blades to pass through the block" is generic to any situation where there is relative movement between the cutting blades and the block. The blades are no less caused to move through the block because the block is moved (as in appellants' disclosed apparatus) than they would be if the blades were moved.

(b) The examiner finds the "means for moving said aligned block" recited in lines 6 to 9 of claim 2 to be confusing because "it appears to be the same previously recited 'remotely controlled means for positioning ... said retainer'" (answer, page 6). We do not agree. The "means for moving" in claim 2 is not recited as being in addition to the "remotely controlled means" recited in parent claim 1, but rather is claimed as a component thereof. Thus, claim 2 recites (numbers in brackets added):

> 2. The apparatus of claim 1 wherein the means for remotely positioning the block of energetic material between the cutter and the retainer comprises [1] a carousel ... , and [2] a means for moving said aligned block ....

We do not consider that there is any confusion about what claim 2 covers, particularly when it is read in light of the specification, as it must be. In re Merat, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975).

(c) The examiner considers claims 6 and 9 to be indefinite in that the terms "the cutter" in claim 6 and "the means for remotely forcing" in claim 9 lack clear antecedent basis. Also, "claim 6 is a method claim but it is unclear what additional methods [sic] steps are being recited" (answer, page 6). Since the appellants did not address these grounds in their brief, the rejection will be sustained as to claims 6 and 9.

(d) The final basis for the § 112 rejection is (answer, page 6, original emphasis):

> Claim 8 is vague and indefinite and is of undue breadth since only a single means is positively recited, i.e., "a means for...positioning".

The examiner further elaborates on page 12 of the answer that:

> The "cutting means" and "the means for remotely causing the cutting means to pass through the block of propellant" are not positively recited. Therefore, the claim is a single means claim which is vague and indefinite and of undue breadth.

We will not sustain this ground of rejection. Claim 8 recites three means, i.e., "a means for remotely positioning," "a cutting means" and "a means for remotely causing." While the

latter two means might be more positively recited, the claim requires all three means, and therefore we do not consider that it amounts to a "single means" claim.[4]

Rejection (2)

The basis of this rejection is fully set forth on pages 6 and 7 of the examiner's answer. Appellants argue that (brief, pages 7 to 8):[5]

> Costarelli nether explicitly or implicitly suggests such a [remote positioning] device and to expect someone to examine the food art to find a reference [Lamb] which at the very best discloses a quasi remote controlled device for loading material for cutting is neither fair, just or within the law.

To the extent that this may constitute an argument that Lamb is nonanalogous art, we do not agree. Even if Lamb may not satisfy the first part of the two-part test set forth in In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979), it satisfies the second part in that it is reasonably pertinent to the particular problem with which the inventor was involved.

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[4] We also note that it has been held that a single means claim is properly rejected under the first paragraph of § 112, rather than the second paragraph. In re Hyatt, 708 F.2d 712, 714, 218 USPQ 195, 197 (Fed. Cir. 1983).

[5] All references herein to appellants' brief are to the brief filed on May 2, 1996 (Paper No. 15).

After considering the record in light of the arguments presented by appellants and the examiner, we conclude that the apparatus recited in claims 1, 8 and 9 would have been obvious over Costarelli in view of Lamb. While a remote positioning device would not be required to protect the operator of the Costarelli apparatus from the inert material being cut thereby, the use of such a device for loading the material M into the Costarelli apparatus would have been suggested, as the examiner states, "in order to eliminate the need for the operator to contact and position the work between the cutter and the retainer" (answer, page 7), and to "eliminate the need for an operator to manually feed and position the work between the retainer and cutting means" (id., page 13). While this motivation for modifying Costarelli by adding a remotely controlled positioning means as disclosed by Lamb might be different from appellants' purpose in using such a means, such difference in purpose does not affect the obviousness of combining the references. In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990). Rejection (2) will therefore be sustained.

Rejection (3)

We will not sustain this rejection. Method claims 5, 10, 11 and 13 are drawn to methods of cutting block explosives or reducing block propellant. Costarelli, the only reference applied in this rejection, discloses a method of cutting thermoplastic waste materials, and does not teach or suggest using the method to cut material of the type recited in these claims. The fact that the Costarelli apparatus could be used to cut blocks of energetic material as argued by the examiner, does not make it obvious to do so, absent some suggestion thereof in the prior art.[6] Cf. In re Osplack, 195 F.2d 921, 923, 93 USPQ 306, 307 (CCPA 1952).

Rejections (4) and (5)

These rejections are grounded on the examiner's finding that it would have been obvious to provide the apparatus of Costarelli with a remotely controlled carousel in view of the disclosure of such a carousel by Kühnert.

[6] By contrast, we have sustained Rejection (2), supra, because the recitation of energetic or propellant material does not distinguish the claimed apparatus over the prior art. See In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967) and In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (recitation of a new intended use for an old product does not make a claim to that old product patentable).

After considering the rejections as stated in the examiner's answer in view of the arguments in the reply brief and in the supplemental examiner's answer, we conclude that these rejections are not sustainable.

Appellants argue that Kühnert is nonanalogous art, and that the examiner has engaged in improper hindsight reconstruction in combining the references. Assuming, of which we are doubtful, that Kühnert is analogous art, we perceive no teaching, suggestion or motivation for one to use a carousel to supply the thermoplastic waste material to Costarelli's shearing machine. The examiner asserts that this would avoid frequent feeding of blocks M to the machine, but such blocks would still have to be loaded into the carousel. The Kühnert carousel is a somewhat complex device which is disclosed as being used to supply biological or other specimens to a microscope for inspection. In our view, one of ordinary skill would not derive therefrom any suggestion to use such a device for supplying blocks of thermoplastic waste to a shearing machine.

Rejections Pursuant to 37 CFR § 1.196(b)

(1) Claims 1 and 8 to 10 are rejected under 35 U.S.C. § 102(b) as anticipated by Nix, which discloses an apparatus and method for remotely cutting blocks of propellant material. A block of

propellant 42 is positioned by remotely controlled cylinder 26 onto cutting surface 70 between cutter 18 and retainer 24. Remotely controlled cylinder 12 causes cutter 18 to pass through the block, creating a multitude of pieces consisting of a sample (Fig. 4) and excess cuttings (col. 3, line 1). With regard to the "one or more cutting blades" recited in claim 1, it is noted that Nix discloses that the cutter has a cutting surface (col. 2, lines 11 to 13), and a skilled artisan would know that such a cutting surface would inherently constitute a cutter blade in the shape of the sample, similar to a cookie cutter. Cf. In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), cert. denied, 116 S.Ct. 1362 (1996).

2. Claim 11 is rejected under 35 U.S.C. § 103 as unpatentable over Nix. Whether cutter 18 of Nix moves and retainer 24 remains stationary, or vice versa, would be simply an obvious matter of design choice.

Conclusion

The examiner's decision to reject the claims on appeal (1) under 35 U.S.C. § 112, second paragraph, is affirmed as to claims 6 and 9, and reversed as to claims 1 to 5, 8, 10, 11 and 13, and (2) under 35 U.S.C. § 103 is affirmed as to claims 1, 8 and 9 and

reversed as to claims 2 to 6, 10, 11 and 13. Claims 1 and 8 to 11 are rejected pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

> (b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART, 1.196(b)

IAN A. CALVERT Administrative Patent Judge	)	
HARRISON E. McCANDLISH Senior Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MURRIEL E. CRAWFORD Administrative Patent Judge	)	

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